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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,176	10/23/2000	Christopher J. Warren	1012-065D1	9544

7590 03/24/2004

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EXAMINER

LEADER, WILLIAM T

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/694,176		WARREN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	William T. Leader		1742	

5/1

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-34 and 38-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-34, 38-43 and 45 is/are rejected.
- 7) ☒ Claim(s) 43 and 44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20031222</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Receipt of the papers filed on December 22, 2003, is acknowledged. New claims 38-45 have been presented. Claims 30-34 and 38-45 are pending.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

3. Claim 30 is rejected under 35 U.S.C. 102(e) as being anticipated by Chow (5,955,028) for the reasons of record and in view of the following comments.

4. Claims 31 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Yee (5,672,256) for the reasons of record and in view of the following comments.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 30-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. Claim 31 was directed to a system for electrochemically screening an array of materials. Applicant has amended claim 31 to recite that the previously recited array of individually addressable electrodes comprises different materials. Basis for this limitation in the specification as filed is not apparent. The only description of such different materials in the specification is in relation to the materials to be tested by the array of electrodes. For example, at column 2, lines 46-49 it is states that "The invention provides method and apparatus for electrochemically depositing distinct materials on arrays of individually addressable electrodes." The distinct materials deposited are those to be tested. This is apparent from column 6, lines 58-60 which state that "The electrochemical cell used to measure properties of the materials deposited on the above describes electrode arrays is illustrated in FIGS. 4A-4E." The specification contains no apparent description of a system for screening materials in which the electrode array itself is made of different metal materials.

### *Response to Amendment*

8. Applicant's arguments have been carefully considered but are not deemed to be persuasive. Applicant notes that claim 30 recites different metals, the metal materials being presented for screening. Applicant argues that neither Chow not

Yee teach a system for electrochemically screening that comprises an array of different metal materials. Applicant's arguments are not persuasive. The amendments to claim 30 and the arguments are directed to the intended use of the apparatus. It is well-settled that the material worked upon does not limit apparatus claims. See MPEP2115. Thus the recitation of the material to be screen by the apparatus is not sufficient to distinguish the claimed apparatus from that of Chow or Yee. .

***Claim Rejections - 35 USC § 103***

9. Claims 38-42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yee alone or in view of Chow.

Newly presented claim 38 recites a system for electrochemically screen an array of materials. As discussed in the previous office action, the system of Yee includes an array of individually addressable electrodes, a counter electrode and a multi-channel potentiostat. Claim 38 recites a housing for containing a test solution such that two or more of the addressable electrodes contact the test solution. Yee is silent as to the presence of a housing. However, in order for the apparatus of Yee to function as disclosed the material being tested must contact more two of more of the addressable electrodes. It would have been obvious at the time the invention was made to have provided a housing sealingly engaged as recited in claims 38 and 39 because the material being tested would have been

contained on the electrodes and protected from contamination during testing. Yee additionally discloses a printed circuit with contact pads disposed on the periphery providing electrical communication to the potentiostat as recited in claims 40-42.

Chow is applied in the previous action and discloses in figure 4 a test system having a housing to receive the adapter plate 314 which in turn receives sample substrate 316. It would have been obvious at the time the invention was made to have provided the apparatus of Yee with a housing as disclosed by Chow because the sample substrate would have been securely held and protected.

#### *Allowable Subject Matter*

10. Claims 43 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William T. Leader whose telephone number is 571-272-1245. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William Leader  
March 17, 2004

ROY KING  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700